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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,174	06/29/2001	Kevin Paul Downes	159.1.847	9551

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WATOV & KIPNES, P.C.  
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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/896,174	<b>Applicant(s)</b> DOWNES ET AL.	
	<b>Examiner</b> Mark T Henderson	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Request for Continued Examination***

1. The request filed on March 4, 2004 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/896,174 is acceptable and an RCE has been established. An action on the RCE follows.

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2. Claim 1 has been amended for further examination.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al.

Walker et al discloses in Fig. 2, a lottery ticket comprising a first game area (120) having a plurality of rows (120E-120G or 3 rows) having a first end (right side of block 120E) containing a plurality of play indicia; a second game area (130) comprising one row (130E) and the same number of rows as the first game area ( 120) and being adjacent the first end of the corresponding row of the first game area; a prize area (140) comprising prize designations for at least one of the rows of the first game, wherein a player may win the prize designation set forth in the prize area.

However, Walker et al does not disclose target indicia; wherein the first game area has a plurality of rows play indicia appearing on the face of a dice; wherein the first game area has from

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3 to 6 play indicia present therein; and a third play area for designating a bonus prize, additional play numbers, additional target indicia or a multiplying feature.

In regards to **Claims 1**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate as many play indicia as desired in the first game area, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include as many play indicia on the playing card, since applicant has not disclosed the criticality of having a particular number of playing indicia, and invention would function equally well with any desired playing number.

In regards to **Claims 1, 3 and 6**, wherein the second game area designates a target indicia which if present in only the corresponding adjacent row of the first game area may result in a prize being won; wherein first game area play indicia corresponds to the target indicia from the corresponding adjacent row of the second game area; wherein the indicia of the first game area are combined to obtain the target indicia in the second game area; and wherein the target indicia in the second game area are obtained by combining at least two play indicia from the first game area, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a

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manipulative difference as compared to the prior art. Therefore, the indicia in the first and second game area is capable of being obtained in any desirable manner.

In regards to **Claims 1, 4 and 5**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any type of indicia as play indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of gaming card does not alter the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of background play indicia such as dice or cards, since applicant has not disclosed the criticality of having the background play indicia, and invention would function equally as well with any indicia.

#### *Response to Arguments*

4. Applicant's arguments filed on March 4, 2004 have been fully considered but they are not persuasive.

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In response to applicant's arguments that the prior art does not disclose or suggest that the first game has anything to do with the playing of the game in the second game area, wherein the "game areas interact with each other in such a manner that each row of the corresponding game area may provide a target indicia which if present in only the corresponding first game area will result in a prize being won", the examiner submits after further review of the claims, that the Walker et al reference does indeed disclose a lottery ticket having a first game area, second game area, and a prize area. However, Walker does not disclose how the indicia in the first game area and second game area are obtained and correspond with each other. The examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the indicia in the first and second game area is capable of being obtained in any desirable manner. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any type of indicia as play indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of

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gaming card does not alter the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (game indicia) and the substrate (card) which is required for patentability.

### ***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Glendinning discloses a similar lottery ticket with similar structure.



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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

May 17, 2004



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